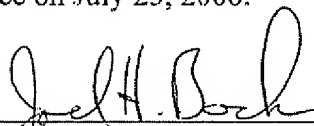


**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In Re Application of:	)	
	)	
Bruce P. Konen	)	Art Unit: 3723
	)	
Serial No.: 10/688,449	)	Examiner: Hadi Shakeri
	)	
Filed: October 17, 2003	)	
	)	
For: Pliers with Protected Indicia on	)	
the Handles	)	
	)	
Confirmation No.: 1569	)	

I hereby certify that this correspondence is being filed electronically with the EFS-Web system of the United States Patent and Trademark Office on July 25, 2006.

  
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**APPEAL BRIEF**

Dear Sir:

This is an appeal from the final Office Action, mailed November 25, 2005. The Notice of Appeal was filed on May 25, 2006.

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**I. REAL PARTY IN INTEREST**

The real parties in interest in this appeal are IDEAL Industries Inc., assignee of the invention claimed in the above referenced application, which assignment was recorded in the United States Patent and Trademark Office at Reel No. 014627 and Frame No. 0967 on October 17, 2003.

**II. RELATED APPEALS AND INTERFERENCES**

There are no related appeals or interferences.

**III. STATUS OF CLAIMS**

Claims 1-15 are currently pending and all have been finally rejected in the Office Action mailed November 25, 2005. Applicant is appealing the rejection of pending claims 1-15.

**IV. STATUS OF AMENDMENTS**

In response to the non-final Office Action mailed June 8, 2005, Applicants filed a response on September 8, 2005 which amended independent claims 1, 6 and 11. Subsequently, the final Office Action mailed November 25, 2005 acted on the previous amendment and finally rejected all the claims, 1-15. No amendments have been made following the final Office Action of November 25, 2005.

**V. SUMMARY OF CLAIMED SUBJECT MATTER**

The present invention is generally directed to hand tools having indicia or markings used to identify the particular type of tool. More particularly, the invention relates to hand tools having indicia located on protected surfaces of one or more handles of the hand tool. The invention also encompasses a method of identifying a hand tool.

While it is known to place markers or indicia on a tool handle to indicate the type of tool, these markers or indicia are applied to areas of the tool handle that are susceptible to wear and abrasion and that are susceptible to being obscured by adjacent tools. See paragraph 0003.

To overcome these deficiencies, the subject of independent claims 1 and 6 is directed to a hand tool having two handles (10, 12) pivotally connected to one another and terminating at a free end. (See paragraph 0007 and FIGS. 1 and 2). Portions of the handle adjacent the terminating ends are convex and have inner surfaces (24) facing each other. (See paragraph 0008 and FIGS. 1 and 2). In normal, one-handed operation of the tool, the palm and fingers of a user's hand will wrap around and contact the first and second planar surfaces (18, 20) and the outer surfaces (22) of the handles but they will not engage the inner surfaces (24). (See paragraph 0008 and FIGS. 1 and 2). Since each inner surface is protected by the opposite handle, the inner surface is not subjected to wear or abrasion from a user's hand. (See paragraph 0008 and FIGS. 1 and 2). Accordingly, the inner surfaces are also referred to as protected surfaces. (See paragraph 0008).

Indicia or markings (26 or 28) are located on the convex end portion of the inner surface (24) of at least one of said handles (10 or 12) and indicating the type of the tool, or are located on a protected surface (24) of at least one of said handles (10 or 12). (See paragraph 0009 and FIGS. 1 and 2). Claim 11 is a method of identifying a tool having the above-described features except that the indicia are placed on the convex end portion of the inner surface (24) of at least one of said handles (10 or 12).

The advantages the hand tool of the present invention are at least twofold: The indicia or markings are less vulnerable to wear and abrasion which can result in making the marking

unintelligible (see at least paragraph 0008); and the indicia are less likely to be visually obscured by an adjacent tool (see at least paragraph 10 and FIG. 2).

**VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

A. Whether claims 1-15 are unpatentable under 35 USC 103(a) over U.S. Patent No. 5,421,224 to Bond (hereinafter, Bond) in view of U.S. Patent No. 3,675,359 to Ohno (hereinafter, Ohno).

B. Whether claims 1-15 are unpatentable under 35 USC 103(a) over Ohno in view of Bond.

**VII. ARGUMENT**

A. The rejection of claims 1-15 under 35 USC 103(a) over Bond in view of Ohno is in error and must be reversed.

Claims 1-15 were rejected under 35 USC 103(a) as unpatentable over Bond in view of Ohno. It was stated that Bond discloses all the limitations of claims 1, 6, and 11, “i.e., a hand tool having two handles” pivotally connected to each other, “each handle having first and second planar surfaces joined by inner and outer surfaces, and indicia located on the inner surface of at least one of said handles and indicating the type of said tool, each handle terminating in a tool head portion, wherein said indicia is located on the inner surface of both of said handles, except for disclosing a handle having convex portions relative to each other and placing the indicia on the inner surface of the convex portions.” It was then stated that pliers with grips having convex distal ends are old and known as disclosed by Ohno and that it would have been obvious to modify the invention of Bond with the ergonomically shaped grips of Ohno.

First, Bond does not disclose indicia on the inner surface of both handles, the indicia are on the butt or terminal ends of the handle and the side surfaces of the handles. Apparently, Bond

also does not disclose planar surfaces. Bond does disclose hand tools such as screw drivers and pliers having markings or indicia indicating the tool type. In the case of pliers, Bond discloses markings or indicia on the terminal ends of the pliers and the side surfaces of the handles, i.e. the surfaces of the handles which are contacted by the user's hand under normal operating conditions. Bond provides no disclosure or suggestion of the need to protect the indicia. Thus, there is no motivation in Bond to alter the location of the indicia from the butt or terminal end or from the side surfaces shown in Bond.

Ohno is being cited for disclosing handles having convex distal ends. We take it the examiner means by this that the free ends of the Ohno handles are convex. However, it is important to note that the feature of convex distal ends of the handles is not a feature recited by the present claims. It is the inner surfaces of applicant's handles that are convex and contain the indicia. Further, Ohno has no disclosure, discussion, showing or suggestion of indicia whatsoever. All Ohno can add in the present context is convex distal ends of the handles — again a feature not recited by the claims. Adding Ohno in other words does nothing to cure the deficiency of Bond. Consequently, even if Bond is modified to have the convex distal ends of Ohno, the subject matter as recited in claims 1, 6 and 11 would still not be met by this combination. Specifically, the combination would still not teach or suggest at least the features of: handles having inner surfaces, which are the portions of the first and second handles facing each other, the inner surfaces being convex relative to one another at least at an end portion adjacent the free end; and indicia located on the convex end portion of the inner surface as recited in claims 1 and 11. Claim 11 is written in the form of a method claim. Claim 6 includes the features of handle portions being convex relative to one another, at least at an end portion adjacent the free end, having protected surfaces facing one another on the convex end portion,

and an indicia located on a protected surface. In more simple terms, the posited combination of references would still lack the convex end portion adjacent to the free end of the inner or protected surface, and indicia located thereon.

It was also noted in the Office Action that the disclosure of Bond for placing the indicia at the end of the grip (see FIG. 8 of Bond) for the “ergonomically” shaped handle grips (we assume as taught in Ohno) would meet the limitations as recited. Again, this indicates a misunderstanding of the limitations recited by claims 1, 6, and 11 since the limitations do not recite indicia located on the terminal free end. Indeed, claims 1, 6, and 11 recite handles terminating at a free end but that is not where the indicia is located. Instead, Bond would still require the modification of both the location of the indicia and the structure of the handles to meet all the limitations of claims 1, 6, and 11. Accordingly, adding the disclosure of Ohno to Bond does not meet all the limitations of claims 1, 6, and 11.

For at least these reasons, the rejection of the claims must not be allowed to stand.

Furthermore, even assuming Ohno discloses the structure of the handles as recited in claims 1, 6, and 11, which it does not, it would still be improper to combine Ohno or such a reference with Bond because Bond teaches away from relocating the indicia to inner or protected surfaces as recited in claims 1, 6, and 11 of the present application. Relocating the indicia on the inner or protected surfaces of the Bond handle would render the indicia useless since the Bond handles are curved toward each other. Any view of the indicia from above would be effectively blocked or obscured by the ends of the handles. Accordingly, the very purpose of the indicia, namely quick identification of the tool type while it rests in a pouch or on a tool belt, would be defeated in Bond if the indicia were placed on the inside surface of the handle(s).

Applicant submits that it cannot be obvious to modify the location of the indicia in Bond when doing so effectively conceals the indicia. Such a combination could only come about through the improper use of applicant's disclosure as a guide to pick and choose features needed from the prior art.

For at least the foregoing reasons, applicant respectfully requests that the rejection of the claims be reversed.

B. The Rejection of Claims 1-15 under 35 USC 103(a) over Ohno in view of Bond is in error and must be reversed.

Claims 1-15 were also rejected under 35 USC 103(a) as being unpatentable over Ohno in view of Bond. It was stated that "Ohno meets all the limitations of claims 1, 6, and 11, i.e., pliers shaped hand tools having two handles, each handle having first and second planar surfaces joined by inner and outer surfaces, with convex inner surfaces, except for disclosing indicia. Bond teaches placing indicia (70) located on a distal end of the handles indicating the type of pliers." Based on this, it is stated that it would have been obvious to modify "Ohno with the indicia as taught by Bond to adapt the tool with marking indicating the type and/or size of the tool."

Applicant submits that Ohno does not disclose convex inner surfaces. The only structure approximating a "convex inner surface" would be the free ends of the handles of Ohno (which are referred to in the Office Action as the distal ends). It is submitted that at most what Ohno has are convex butt ends of the handles. The butt ends of Ohno are not convex inner surfaces or convex protected surfaces. Ohno's convex butt ends are not what is recited in the claims. As indicated above, claims 1 and 11 recite inner surfaces being convex relative to one another at least at an end portion adjacent the free end, and claim 6 recites handle portions being convex



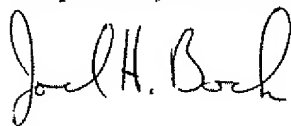
relative to one another at least at an end portion adjacent the free end and having protected surfaces facing one another on the convex end portion. Consequently, any combination with Bond would still lack these recited features.

Even if Ohno disclosed such features, which it does not, the addition of Bond would still lack the feature of having indicia located on the convex end portion of the inner surface, as recited in claims 1 and 11, and indicia located on a protected surface, as recited in claim 6. The addition of Bond would only teach indicia located on the butt or terminal ends or on the side surfaces. As indicated above, Bond is neither concerned with nor does he even recognize the need to protect the indicia from wear or abrasion. So there could be no motivation or suggestion to locate the indicia on the inner or protected surfaces as recited in claims 1, 6 and 11.

Indeed, locating the indicia on the inner surfaces of the Bond or the Ohno handles would be counterintuitive and counterproductive since the indicia would be visually obscured by the inward curvature of the handles. There would be no motivation to make such a modification, i.e., to relocate the indicia since it would defeat the purpose of the indicia.

For the foregoing reasons, applicant respectfully requests that the rejection of the claims be reversed.

Respectfully submitted,



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Dated: July 25, 2006

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**VIII. CLAIMS APPENDIX**

1. A hand tool having two handles pivotably connected to one another, the handles terminating at a free end, each handle having first and second planar surfaces joined by inner and outer surfaces, said inner surfaces being the portions of said first and second handles facing each other, said inner surfaces being convex relative to one another at least at an end portion adjacent the free end, and indicia located on the convex end portion of the inner surface of at least one of said handles and indicating the type of said tool.

2. The hand tool of claim 1 wherein said indicia is located on the inner surface of both of said handles.

3. The hand tool of claim 1 further comprising a sleeve on at least one of said handles, and wherein the indicia is located on the portion of the sleeve that covers the inner surface of the handle.

4. The hand tool of claim 1 wherein the handles terminate in a tool head and the indicia indicates the size of the tool head.

5. The hand tool of claim 1 wherein the handles terminate in a tool head and the indicia indicates the type of the tool head.

6. A hand tool comprising first and second handle portions pivotably connected to one another and terminating at a free end, said handle portions being convex relative to one another at least at an end portion adjacent the free end and having protected surfaces facing one another on the convex end portion, each handle terminating in a tool head portion, and an indicia located on a protected surface of at least one of said handles.

7. The hand tool of claim 6 wherein indicia are located on a protected surface of more than one of said handles.

8. The hand tool of claim 6 wherein said indicia is integral with said handle.
9. The hand tool of claim 6 further comprising a sleeve on each of said handles, wherein said indicia is located on one of said sleeves.
10. The hand tool of claim 9 wherein said indicia is integral with said sleeve.
11. A method of identifying a tool having at least two handles being pivotably connected to one another, the handles terminating at a free end, a tool head, and inner surfaces, said inner surfaces being the portions of said first and second handles facing each other and wherein said inner surfaces are convex relative to one another at least at an end portion adjacent the free end, said method comprising the step of placing an indicia on the convex end portion of the inner surface of at least one of said handles.
12. The method of claim 11 wherein said indicia indicates the type of said tool head.
13. The method of claim 11 wherein said indicia indicates the size of said tool head.
14. The method of claim 11 wherein said indicia is integrally formed with said handles.
15. The method of claim 11 wherein said tool further comprises a sleeve, and wherein said indicia is integrally formed with said sleeve.

**IX. EVIDENCE APPENDIX**

None.

**X. RELATED APPEALS APPENDIX**

None.